

Application No. 10/708,928  
Amendment dated April 10, 2006  
Reply to Office Action of February 8, 2006

Docket No.: 60680-1780

**AMENDMENTS TO THE DRAWINGS**

The attached sheet(s) of drawings includes changes to Sheet 2, FIGS. 3 and 4.

Attachment: Replacement sheets for Sheet 2, including FIGS. 3A, 3B, 3C, 3D, 3E, 3F, 4A, 4B, 4C, 4D, 4E, and 4F.

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REMARKS

Applicants have carefully reviewed the Office Action mailed February 8, 2006, and thank Examiner Sharp for his detailed review of the pending claims. In response to the Office Action, Applicants have amended claims 1 and 7. By way of this amendment, no new matter has been added. Claim 2 was previously cancelled, and claims 13-18 have been withdrawn by the Examiner. Accordingly, claims 1 and 3-21 remain pending in this application. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

Drawings

FIGS. 3 and 4 were objected to as illegible. Accordingly, each of FIGS. 3 and 4 have been divided into 6 sub-figures with "Initial" on each sub-figure, and "Day 3", "Day 7", "Day 10", "Day 14", "Day 17", and "Day 21" on each respective subfigure. With these individual data points illustrated on different sub-figures, the data presented is readily legible. Withdrawal of this objection is respectfully requested.

Amendments to the Claims

Independent claims 1 and 7 have been amended to include "while generally maintaining a seal therebetween." Support can be found, at least, in paragraph [0019], which recites "the pressurization testing indicates that the fastener assembly 10 of the invention maintains the sealing action between the valve cover and the cylinder head as well, if not better, than the conventional fastener assembly using a rubber grommet."

Claim Rejections – 35 USC § 102

Claims 1, 3, 4, 6-9, 11, 12 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent JP 11050842 to Ando Tokuji. Applicants respectfully traverse the rejection.

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To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 positively recites a fastener assembly that "acoustically decouples the components while generally maintaining a seal therebetween." In contrast, JP 11050842 teaches a bolt 4 that couples an exhaust manifold cover 1 and an exhaust manifold 2 to "capable of sufficiently absorbing expansions and contractions caused by heat," that does not seal between the exhaust manifold cover 1 and the exhaust manifold 2. Importantly, JP 11050842 teaches a connection between components where relative movement and separation are desirable, and the woven wire mesh 5 in addition to the gap between the exhaust manifold cover 1 and the collar 3 will provide a leakage path through the connection. Furthermore, one of skill in the art would appreciate that a seal is undesirable between a heat shield and an exhaust manifold, since an exhaust manifold heat shield will desirably permit air to pass between the exhaust manifold cover 1 and the exhaust manifold 2 to allow heat to radiate away from the exhaust manifold 2.

Independent claim 7 positively recites a fastening system that "acoustically decouples the at least two components while generally maintaining a seal therebetween." In contrast, JP 11050842 teaches a bolt 4 that couples an exhaust manifold cover 1 and an exhaust manifold 2 to "capable of sufficiently absorbing expansions and contractions caused by heat," that does not seal between the exhaust manifold cover 1 and the exhaust manifold 2.

Thus, JP 11050842 does not teach every limitation of independent claims 1 and 7, as required in *Verdegaal Bros.* Dependent claims, 3, 4, 6, 8, 9, 11, 12 and 20 are also patentable by being dependent on an allowable base claim. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

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### Claim Rejections – 35 USC § 103

#### All Elements

The remarks presented above with respect to the §102 rejection are equally applicable here. Specifically, the inadequacy of JP 11050842 to teach every element of independent claim 1 by not teaching a seal between the exhaust manifold cover 1 and the exhaust manifold 2, is also fatal to the Examiners §103 rejections that each rely upon JP 11050842.

#### Non-Analogous Art

Furthermore, *In re Oetiker* presents a test for analogous art as “whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor.” 24 USPQ2d, at 1445 (Fed. Cir. 1992). “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must be either in the field of the applicant’s endeavor, or, if not, reasonably pertinent to the particular problem with which the inventor was concerned.” *Id.* As mentioned above, one of skill in the art would appreciate that a seal is undesirable between a heat shield and an exhaust manifold, since an exhaust manifold heat shield will desirably permit air to pass between the exhaust manifold cover 1 and the exhaust manifold 2 to allow heat to radiate away from the exhaust manifold 2. Accordingly, JP 11050842 is not in the field of the applicant’s endeavor of acoustically decoupling components “while generally maintaining a seal therebetween,” and is therefore non-analogous art.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure.” *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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### CLAIM 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11050842. Applicant respectfully traverses the rejection.

When rejecting a claim based upon a sole 35 U.S.C. 103(a) reference, the Federal Circuit has provided some guidance. Specifically, *In re Gordon* provides that “[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, the Federal Circuit has held that “[i]t is not pertinent whether the prior art device possesses the functional characteristics of the claimed invention if the reference does not describe or suggest its structure.” *In re Mills*, 16 USPQ2d 1430, 1433 (1990).

In addition to the failure of JP 11050842 to teach all elements of independent claim 1, as detailed above, Applicants also agree with the Examiner that JP 11050842 does not teach “what material the assembly parts are manufactured from.” (Non-Final Office Action dated February 8, 2006, page 5). Accordingly, withdrawal of this rejection is respectfully requested.

To the extent the Examiner intends to take Official Notice of known materials for use as wave springs, Applicant seasonably requests that the Examiner provide documentary evidence to support the taking of Official Notice as is required by 37 CFR § 1.104(d)(2) and MPEP § 2144.03.

### CLAIMS 10 AND 21

Claims 10 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11050842 in view of *Fonville* ‘801. Applicant respectfully traverses the rejection.

#### Same problem as inventor

“The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d, at 1458 (Fed. Cir. 1998)

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The Examiner states “at the time of the invention, it would have been obvious to one of ordinary skill in the art, to employ the fastening assembly taught in JP 11050842 in between the valve cover and engine block as suggested by Fonville.” However, the Examiner fails to appreciate that Fonville teaches a mounting “for noise isolation and sealing.” (Fonville, column 1, lines 7-8). Accordingly, one of skill in the art, confronted with the problem of the Applicants, would *select* the teachings of Fonville *instead* of combining JP 11050842 and Fonville, since Fonville teaches a solution to the problem that is complete with no features lacking. Therefore, one of skill in the art would not make the proposed combination, as required in *In re Rouffet*.

#### No Motivation for the Proposed Combination

There must be “something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed Cir. 1998).

*In re Fritch* provides that “the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art,” and that “the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” 23 USPQ2d. 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit has concluded that “under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* (Emphasis in original).

The Examiner has provided motivations for the proposed combination, not found in either JP 11050842 or Fonville, as “guarantee better service life”, reduce isolator wear, suspend the valve cover in a “freely vibrating manner”, and/or prevent the transmission of “solid-borne sound”. However, these motivations to combine the prior art do not appear to be directed to any deficiency of either JP 11050842 or Fonville, and would apparently offer no advantage for the mounting of either JP 11050842 or Fonville. Accordingly, one of skill in the art would not make the proposed combination in light of any of the Examiner’s supplied motivations, since these motivations would not provide any incentive to make the combination.

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**Proposed Combination makes the Prior Art Reference Wholly Unsuitable**

If the proposed modification makes the prior art reference wholly unsuitable for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). If the proposed modification or combination of references would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As noted above, the mounting of JP 11050842 cannot provide a seal between two components. The Examiner has modified the valve cover 19 and cylinder head 12 of Fonville with the mounting of JP 11050842 to attempt to arrive at claims 10 and 21. However, the proposed modification would result in a connection between the valve cover 19 and cylinder head 12 that does not provide a seal therebetween. As stated in Fonville, the mounting between the valve cover 19 and cylinder head 12 provides a seal. (Fonville, Abstract, All Claims, column 1, lines 6-8, and Column 1, line 30 to column 4, line 25). Indeed, ‘seal,’ ‘sealed,’ and/or ‘sealing’ is in virtually every sentence of Fonville. Accordingly the proposed modification makes Fonville wholly unsuitable for its intended purpose, and cannot support a *prima facie* case of obviousness, as required in *In re Gordon*. Accordingly, withdrawal of this rejection is respectfully requested.

**CLAIM 19**

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 11050842 in view of Spies ‘099. Applicant respectfully traverses the rejection.

The Examiner has supplied motivations to combine the spring member 4 and screw 6 of Spies with the mounting of JP 11050842 to attempt to arrive at claim 19. However, the proposed combination, even if proper, would not provide any of the embodiments of claim 19, since the proposed combination would not “acoustically decouples the components while generally maintaining a seal therebetween.” Accordingly, withdrawal of this rejection is respectfully requested.

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Conclusion

In view of the above, each of the presently pending claims in this application is in immediate condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1780 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. §1.136 is hereby made, the fee for which should also be charged to this Deposit Account.

Dated: April 10, 2006

(the 8<sup>th</sup> falling on a Saturday)

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Respectfully submitted,

By Kenneth W. Jarrell  
Kristin L. Murphy  
Registration No. 41,212  
Kenneth W. Jarrell  
Registration No.: 52,484  
RADER, FISHMAN & GRAUER PLLC  
39533 Woodward Avenue  
Suite 140  
Bloomfield Hills, Michigan 48304  
(248) 593-3310  
Attorneys for Applicant

Attachments